

No. 3618 <sup>6</sup>

IN THE  
**United States Circuit Court of Appeals**  
For the Ninth Circuit

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MAJESTIC ELECTRIC DEVELOPMENT COMPANY  
(a corporation),

*Appellant,*

vs.

WESTINGHOUSE ELECTRIC & MANUFACTURING  
COMPANY (a corporation),

*Appellee.*

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**BRIEF FOR APPELLEE.**

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WESLEY G. CARR,

DAVID L. LEVY,

WALTER SHELTON,

*Solicitors for Appellee.*

FILED



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**BRIEF FOR APPELLEE.**

This is an appeal in a patent infringement suit in which the appellant was the plaintiff in the lower court.

For convenience, the parties will be referred to here as the plaintiff and the defendant.

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**SUBJECT MATTER.**

The basis of this suit is design letters patent No. 51,253, granted to the plaintiff-appellant upon an application filed by Edmund N. Brown and purporting to cover a design for an electric heater casing.

*The design constituting the subject-matter of the patent in suit differs from that constituting the subject-*

*matter of the patent involved in the companion suit No. 3616 in the omission of the protective casing and its annular peripheral flange and in no other material respect.*

The heater embodying the design of the patent in suit is characterized by portability, and embodies essential elements, as follows: an electrical heating unit, a concavo-convex reflector, a wire cage or guard and a supporting stand, *all occupying a co-operative relation to each other that is dictated by FUNCTIONAL considerations.*

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#### PATENT IN SUIT INVALID.

The design here involved fails to meet the requirements of Section 4929 in substantially the same manner and to the same degree or, perhaps, to even a greater degree than does the design of patent No. 51043 of case 3616.

In view of the close resemblance of the two designs, the citations of, and the quotations from, court opinions construing the statute, as applied to designs embodying neither originality nor ornamental characteristics, need not be repeated here, but the court is requested to consider our brief in case 3616, as applicable to the facts presented by the instant case, in the particulars just mentioned.

The prior art, represented by general well-known practice over a long period of years, and specific patents, publications and prior uses are applicable in the instant case in a manner and to a degree at least equal to their applicability in case 3616. Repetition of our discussion of such prior art is, therefore, omitted from this brief,

but the court is respectfully requested to make reference to such discussion when considering the question of patentability of the design set forth in patent No. 51253.

We request special consideration of the Majestic heaters Nos. 1, 2, 2b and 3 (Defendant's exhibits A, B, C and D); the photograph of the Majestic exhibit at the Panama-Pacific Exposition (Defendant's exhibit E); the Warner patent No. 1,120,003 (Defendant's exhibit H); Shoenberg patent No. 1,109,551 (Defendant's exhibit I); Also the Taylor British patent No. 102,070 of 1916, which substantially illustrates the Majestic No. 3 heater.

Counsel for plaintiff protests against consideration of the last-mentioned patent in this suit, because it was not formally offered in evidence therein. In this connection, it is pertinent to state that three suits against the Westinghouse Electric & Manufacturing Company and one against Holbrook, Merrill & Stetson were tried consecutively and were all argued together. In view of such relation of the cases and the fact that two of the patents in suit against the Westinghouse Company were combined in the suit against Holbrook, Merrill & Stetson, Judge Dietrich wrote a single opinion in disposing of the four suits and, in such opinion, made reference to the above-mentioned Taylor patent as embodying an anticipation of design patent No. 51,253.

Even though the Taylor British patent was not formally offered in evidence in this case, a certified copy of it was regularly placed on file and the opinion of Judge Dietrich has made it a part of this case.

Judge Dietrich made reference to Kempton British patent No. 12,330 of 1848 as disclosing a parabolic reflector for heating purposes, gas jets being disposed in

proper relation to such reflector in order that the heat produced by the burning gas might be thrown forward in a beam.

Counsel for plaintiff objects to any consideration of the British patent just mentioned because it was not formally offered in evidence in any of the three cases now on appeal in this court. This objection by counsel for plaintiff is purely technical, inasmuch as the three suits against the Westinghouse Electric & Manufacturing Company and a suit against Holbrook, Merrill & Stetson were tried consecutively and were all argued together. Inasmuch as Judge Dietrich prepared a single opinion for the four cases just mentioned, he naturally and properly made use of the exhibits without attempting to differentiate as to the specific cases in which they may have been formally offered in evidence. By so doing, he made the Kempton British patent a part of the instant case and this court cannot properly ignore it, provided it is deemed of material value, any more than it can ignore a matter of such common knowledge as to be properly subject to judicial notice, even though not represented by any exhibit or testimony or specifically presented by counsel for consideration of the court.

The plaintiff, having secured the Schoenberg patent which, by reason of the then prior art, was so limited in scope that it could not be utilized to exclude others from the "beam-heater" field, and having designed, manufactured and sold its Nos. 1, 2, 2b and 3 heaters without attempting to secure additional patent protection thereon, its after-thought in attempting to cover, by a design patent, an inconsequential variation from its former designs and thereby compel other manufacturers

to abandon the field or pay tribute is unconscionable and cannot receive the sanction of a court of equity.

The actual features of the plaintiff's exhibits Nos. 2 and 3 which serve to distinguish them from the prior heaters (Nos. 2, 2b and 3) manufactured and sold by the plaintiff are

1. Size, which the plaintiff admits is immaterial and cannot affect the patentability of the design or its infringement.

2. The color, which is no part of the patented design but is the striking feature of plaintiff's exhibits Nos. 2 and 3 and serves, more than anything else, to impress an observer giving such attention as one ordinarily gives to such devices.

The relatively large reflecting bowl of burnished copper is not only pleasing in appearance, because of its color, but it gives to the observer a visible impression of warmth to supplement the heat actually imparted by the reflected rays of energy.

The extent of manufacture and sale of No. 7 heaters by the plaintiff obviously has no significance in the instant case. Inasmuch as the designs of the two patents are not exactly alike and the plaintiff has never sold heaters embodying the specific design shown in the patent in suit, *since the date of issue of that patent*, evidence of sales of No. 7 heaters is unquestionably irrelevant and immaterial.

It is true that the plaintiff has offered in evidence certain advertising circulars which illustrate heaters like or closely resembling that shown in the patent in suit but no evidence has been offered to the effect that such circulars have ever actually been utilized for the



purpose of promoting the sale of such devices or that any such devices have actually been sold.

Counsel for plaintiff states that counsel for defendant urged at the trial in the lower court that design patent No. 51253 is anticipated by design patent No. 51043, and that the court seems to have accepted this view. We take issue with this statement, so far as it alleges or indicates any contention on behalf of the defendant that a patent issued upon an application which was pending concurrently with another application is a prior patent to be utilized as a reference against the patent issuing upon the other application, provided the case is not one of "double patenting".

Our position with reference to these two patents is this: if the defendant's device infringes each of these two patents, its design must be substantially the same as the design of each of the patents and, consequently, since two things which are equal to the same thing are equal to each other, the designs of the two patents must be alike and, since both of them cannot be valid, if embodying the same invention, the later patent is *ipso facto* invalid.

It is impossible to understand in what sense and for what reason counsel for plaintiff relies upon the cage of arched guard wires as a distinctive patentable feature of the design of the patent in suit and as giving the article a distinctive appearance, inasmuch as this device constitutes an element of each of the Majestic heaters Nos. 1, 2, 2b and 3 (defendant's exhibits A, B, C and D), and occupies the same position with reference to the other elements of the device.



**PATENT IN SUIT NOT INFRINGED.**

Counsel for plaintiff alleges, on Page 2 of his brief, that "If patent 51,253 be valid, then it follows conclusively that infringement exists. A casual glance at the two devices is sufficient to prove this contention. Therefore, on this appeal we are concerned only with the question of validity of the patent 51,253, and that is the only question before this court." This statement is not correct. The patent in suit embodies a heating unit that is disposed at right angles to the axis of the reflector, whereas defendant's heating unit is disposed in the axis of the reflector and thus presents a strikingly different appearance. Furthermore, the reflector of the patent in suit is rigidly supported upon the top of a stand of the ordinary desk telephone type, whereas the defendant's reflector is mounted upon trunions in a frame of substantially U shape.

Purchasers of electric heaters are not restricted to a single view and naturally would not examine the heater from in front only; even if they should do so, they would observe, as did Mrs. Lebatt, the difference in arrangement of the heating unit, and if viewed from the side or the rear, the difference between defendant's support and that shown in the patent in suit is not only noticeable, but unmistakable.

One cannot ignore the fact that Fig. 2 of the patent drawing shows the mounting of the reflector on its pedestal and accentuates the structure from which defendant's device is distinguished by its own peculiar form of support.

The statement of counsel for plaintiff that the defendant might have used the four-legged stand of the Ferranti Fires, is beside the mark, although doubtless true, inasmuch as defendant did not adopt a stand of the desk telephone type such as the patentee showed in his drawing, but, in preference thereto, selected a supporting stand like that shown and described in British patent No. 19971 of 1913 and thereby, to that extent, avoided any semblance of infringement of the patent in suit.

Although the defendant's structure obviously embodies a concavo-convex reflector, a heating unit supported in front of said reflector and a protective cage having guard wires the ends of which are attached to the margin or rim of the reflector, *the designers of the defendant's heater secured all of the essential elements incorporated in the heater from the prior art which was also available to Brown when he made the alleged invention of the patent in suit.*

Defendant's device is shown and described in British patent No. 19,971 of 1913, and in defendant's exhibit 9, except as regards the form of the reflector and that of the protective cage.

It will be noted that the supporting member of the defendant's device embodies a base having a frame of U-shape between the arms of which the reflector is mounted upon trunnions and that these parts correspond closely to like parts in the British patent.

It is to be noted, further, that, in the defendant's device, the heating unit comprises a supporting rod, an

insulating cylinder on such rod and a coil of resistance wire disposed on the insulating cylinder, and that this unit is mounted in the axis of the reflector.

Corresponding parts, which differ only as regards the length of the unit, are disclosed in the British patent.

It is to be noted, further, that a more or less definite relation between the length of the heating unit and the depth of the reflector exists and, consequently, inasmuch as the designers of the defendant's heater elected to use a reflector of the form shown in the Warner patent (defendant's exhibit H), they necessarily utilized a heating unit the length of which conforms to the depth of the Warner reflector.

The protective cage of the British patent was rejected as less desirable than other forms known in the prior art and, consequently, substantially the form of that shown in the Porter patent No. 684,459 of October 15, 1901, (defendant's exhibit N) was adopted.

Or it may be assumed that the designers of the Westinghouse heater had knowledge of the specific cage shown in defendant's exhibit 16, which was obviously available to anyone desiring to make use of that specific form of protective cage. The device shown in exhibit No. 16 is the Majestic Company No. 2 heater, as exemplified in defendant's exhibit B, the design of which had been abandoned to the public by commercial exploitation prior to the advent of heaters like plaintiff's exhibits Nos. 2 and 3.

As has already been noted, the design of the patent in suit is characterized by a reflector of bowl-shape sup-

ported upon a stand of the well-known desk-telephone type, a cylindrical heating unit, supported in front of the reflector, with its major axis at right angles to the axis of the reflector and a protective cage of bowl-shape composed of wires the ends of which are attached to the outer edge of the reflector bowl. These several devices are combined to constitute an electric heater of a type generally well known in the art.

The design, as embodied in the plaintiff's exhibits Nos. 2 and 3, does not differ from that shown in the patent in suit except in one striking particular, namely, the reflecting bowl of burnished copper.

Defendant's heater embodies elements the number and general co-operative relation of which are the same as in the plaintiff's heater except that its heating unit is disposed in the longitudinal axis of the reflector instead of at right angles thereto.

One striking difference between the defendant's heater and that of the patent in suit, in addition to the location of the heating unit, is the supporting stand which comprises a base and a frame of U-shape between the upper ends of which the reflector is pivotally mounted in order that it may be tilted.

The defendant's heater resembles the plaintiff's heater only because they both embody the same number of main elements or features having the same general arrangement and substantially the same color.

Defendant is at a loss to understand the plaintiff's position in urging infringement by defendant of both design patent No. 51,043 and design patent No. 51,253.

In view of the well known mathematical axiom that two things that are equal to the same thing are equal to each other, it is fundamental, in the law of design patents, that an infringing design must be like the patented design or it must be what is generally designated as a colorable imitation of such design.

There is no escape from the fact that the design of defendant's heater is not like that of patent No. 51,043 and, therefore, it does not constitute an infringement unless it is a colorable imitation. If a colorable imitation of the design of patent No. 51,043, it is not a patentably different design. By parity of reasoning, if defendant's design infringes patent No. 51,253, it is either like that or is a colorable imitation of it and, since a colorable imitation is, in a patentable sense, substantially the same as an exact copy, the defendant's device, as an infringement of both patent No. 51,043 and patent No. 51,253, must embody a design like that of both patented designs and, therefore, the two patented designs are not and cannot be patentably different.

Since design patent No. 51,043 is earlier in date than design patent No. 51,253, the latter must be invalid in view of the former or the defendant's design does not and cannot infringe both patents.

Although, as clearly shown by the evidence and as already set forth in this brief, the patent in suit embodies no feature of novelty over what is disclosed in prior patents and publications and, even if valid, would not be infringed by defendant's design because of the radical difference in the supporting structure and in the

location of the heating unit, the most important phase of the entire situation to be considered is that **THE PATENTEE BROWN HAS, IN FACT, SECURED A PATENT FOR THE DESIGN OF THE MAJESTIC No. 2 HEATERS WHICH WERE MANUFACTURED AND SOLD BY THE PLAINTIFF MORE THAN TWO YEARS BEFORE BROWN FILED HIS APPLICATION.**

Brown has not only secured a patent upon subject-matter which was dedicated to the public by reason of more than two years' public use, but, so far as the record shows, he filed an application and secured a patent upon a design which was invented by another and incorporated in the No. 2 Majestic heater which is illustrated in defendant's exhibits No. 16 and E and exemplified in defendant's exhibit B.

It may be true, as urged by the plaintiff, that the specific form of the reflector shown in the patent in suit differs slightly from that of the Majestic No. 2 heater, but it is beyond the range of reason and common sense for anyone to admit, much less to urge, that a slight change in the shape of a reflector of a heater of this type, although the change may be of some value, so far as functional performance is concerned, actually imports a new and patentable design.

If the patent in suit is infringed by the defendant's heater it is also infringed by the plaintiff's No. 2 heater—a manifest absurdity.



## CONCLUSION.

It is submitted in conclusion, that the plaintiff-appellant has brought to this Court a cause of action which has no basis in equity—

1st. Because the design of the patent in suit embodies only what was taken from a well developed prior art and is therefore devoid of invention.

2nd. Because every element of the device shown in the patent in suit has a functional purpose and characteristic and no other and that no part of the structure could be omitted or so modified as to materially change the design without omitting or materially changing such functional characteristics, and, therefore, the design is not “ornamental” within the meaning of Section 4929, R. S. U. S.

3rd. Because the relation of the heating unit to the reflector in defendant’s heater differs so radically from that of the corresponding elements of the patented design as to establish non-infringement, the difference being such as to make an instant and striking impression upon the sight and mind of one of plaintiff’s own witnesses.

4th. Because the supporting member of defendant’s heater is so strikingly different from that of plaintiff’s heater that the most casual observer, if possessed of normal intelligence and power of vision, could not mistake the one for the other.

5th. Because every element of defendant’s design and the design as a whole were taken from the prior

art and, therefore, could not have been taken from the plaintiff's patent unless it constituted the medium through which the information was transmitted.

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#### SUGGESTED MISTRIAL

Our comments respecting appellant's suggestion of a mistrial will be found in our brief in case 3616 and we request that such comments be read as pertaining to this case.

Wherefore, it is submitted that the decree of the District Court should be affirmed.

Dated, San Francisco,  
March 5, 1921.

WESLEY G. CARR,  
DAVID L. LEVY,  
WALTER SHELTON,

*Solicitors for Appellee.*